



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,712	12/05/2003	Tsuyoshi Masuda	3071	9956

7590 12/07/2005

WALTER A. HACKLER, Ph.D.
PATENT LAW OFFICE
SUITE B
2372 S.E. BRISTOL
NEWPORT BEACH, CA 92660-0755

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,712

Applicant(s)

MASUDA ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Withdrawn Rejections

1. The objections of claims 1 and 4 in the office action dated August 9, 2005 is withdrawn due to Applicant's amendments and arguments in the response dated October 14, 2005.
2. The 35 U.S.C. 112 2nd paragraph rejection of claims 1 – 11 in the office action dated August 9, 2005 is withdrawn due to Applicant's amendments and arguments in the response dated October 14, 2005.
3. The 35 U.S.C. 102(b) rejection of claims 1, 3 – 7 and 9 – 11 as anticipated by Nibling, Jr. in the office action dated August 9, 2005 is withdrawn due to Applicant's amendments and arguments in the response dated October 14, 2005.
4. The 35 U.S.C. 103 rejection of claims 2 and 8 over Nibling, Jr. in view of Patton et al. in the office action dated August 9, 2005 is withdrawn due to Applicant's amendments and arguments in the response dated October 14, 2005.

New Rejections

Claim Objections

5. Claims 1 and 7 are objected to because of the following informalities: Claims 1 and 7 are objected to because in line 2 of both claims "thermal paper" is used to describe the substrate

Art Unit: 1772

while in the specification, the substrate is referred to “thermal sensitive paper”. In order to clarify the material that is being used, the substrate should be called “thermal sensitive paper” to correlate to the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3 – 7 and 9 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nibling, Jr. in view of Shibata et al. (USPN 4,633,276).

Nibling, Jr. discloses a runnable splice (Column 1, lines 6 – 7) comprising a first thermal imprintable label stock having a first face layer of paper (Column 6, lines 9 – 16), a first liner and a pressure sensitive adhesive disposed there between, the first label stock having a first end disposed transverse to a length of the first label stock; a second imprintable label stock having a second face layer of paper, a second liner and a pressure sensitive adhesive disposed there between, the second label stock having a second end disposed transverse to a length of the second label stock, the first and second ends being disposed in a parallel spaced apart relationship to form a splice gap there between (Column 5, lines 32 – 47); a third imprintable label disposed over said splice gap and adhered to both the first and second face layers for enabling printing over said splice gap (Column 5, lines 48 – 54 – since the tape contains a carrier

Art Unit: 1772

layer and pressure sensitive adhesive, it is inherent that it would also be printable); and a splice tape disposed over said splice gap (Column 5, lines 59 – 60), which is disposed at an angle of about 0 degrees transverse to a longitudinal axis of the first and second stock (Figure 2), and adhered to both the first and second silicone liners (Column 3, lines 60 – 63), the adherence of said splice tape to silicone liner enabling the removal of the liners from the face layer without separating the liners from one another (Column 5, line 65 to Column 6, line 8) as in claims 1, 3 - 5, 7, 9 and 10. Regarding claims 6 and 11, the splice tape has a width that is equal the third external label width (Figure 2). However, Nibling, Jr. fails to disclose the impritable label stock having a layer of thermal paper.

Shibata et al. teach a thermosensitive recording label (Column 2, line 67) having a thermosensitive color-forming layer disposed on one side of the substrate (Column 2, line 68 to Column 3, line 11) made of paper (Column 4, lines 3 – 5) and an adhesive layer covered with a silicone release liner (Column 5, lines 21 – 24) for the purpose of forming a label that is used on a variety of products without fading of the color formations over long periods of time (Column 1, lines 37 – 39).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the thermal paper in Nibling, Jr. in order to form a label that is used on a variety of products without fading of the color formations over long periods of time as taught by Shibata et al.

Art Unit: 1772

8. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nibling, Jr. in view of Shibata et al. as applied to claims 1, 3 – 7 and 9 – 11 above, and further in view of Patton et al.

Nibling, Jr., as modified with Shibata et al., discloses a runnable splice (Column 1, lines 6 – 7) with a splice gap having a width of 0.008 to about 0.06 inches (Column 3, lines 23 – 28) as stated above. However, Nibling, Jr. fails to disclose the third label having a width of between 0.5 inches and about 3 inches.

Patton et al. teach a printable label (Column 6, lines 5 – 7) for using for splicing together end roll materials having a width from 0.5 inches to 1 inches (Column 6, lines 15 – 20) for the purpose of splicing two rolls of material together while presenting information about the rolls of material (Column 2, line 65 to Column 3, line 2).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the label with the desired width in the splicing operation of Nibling, Jr. and Shibata et al. in order to splice two rolls of material together while presenting information about the rolls of material as taught by Patton et al.

Response to Arguments

9. Applicant's arguments with respect to claims 1 – 11 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 1772

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,141,914 to Kang is cited to show the state of the art with regard to the use of thermal paper in printable materials.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln
pln

Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 12/1/05